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10/500,874

07/07/2004

Serge Haumont

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05/18/2009

SQUIRE, SANDERS & DEMPSEY L.L.P.

8000 TOWERS CRESCENT DRIVE

14TH FLOOR

VIENNA, VA 22182-6212

EXAMINER

BRANDT, CHRISTOPHER M

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

05/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/500,874

Applicant(s)

HAUMONT, SERGE

Examiner

CHRISTOPHER M. BRANDT

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This Action is in response to applicant's amendment / arguments filed on February 20, 2009. **Claims 1, 2, and 4-29** are now currently pending in the present application.

Response to Arguments

Applicant's arguments filed February 20, 2009 have been fully considered but they are not persuasive.

With regard to applicant's argument that the combination of Stille and Anderson fails to disclose, teach, or suggest, at least, "selecting, in the network apparatus, the gateway network node of the home network if the mobile station is in a predefined partner network of the home network," the examiner respectfully disagrees. As indicated in the previous communication Anderson teaches classifying service providers such as home service provider, partner service provider and then selects the best service provider (column 3 lines 40-43, 53-65). The examiner notes that if a selection is made using the best service provider, a node has to be selected in order to provide the mobile station with service. Furthermore, in a previous communication, the examiner indicated that Stille teaches this feature / condition in paragraph 30 when Stille teaches that two of the MTs: 2, 3 are subscribed to operator A and operator B, respectively. The HLR:s 10, 11 are contacted and inform the SGSN 9 that the subscribers may use the APS:s 12, 13 that are chosen. Therefore, Stille discloses the limitation, "selecting the gateway network node of the home network if the mobile station is in a predefined partner network of the home network." However, as the examiner previously indicated, Anderson was relied upon to further clarify this particular feature in order to advance prosecution. Therefore, the combination of Stille and Anderson does disclose "selecting, in the network apparatus, the gateway network

node of the home network if the mobile station is in a predefined partner network of the home network."

With regard to applicant's argument that it would not be obvious to combine the solutions of Anderson to the solution of Stille, as Anderson teaches away from the claimed invention, the examiner respectfully disagrees. To the contrary, Anderson and Still are both concerned with selecting / locking on to a preferred network (Stille; paragraph 11, Anderson; column 5 lines 55-67).

The examiner further notes that the "in the network apparatus" amendment still reads on the claims since Still teaches this feature. In addition, whether the mobile station performs the selection (as in Anderson) or the network apparatus is irrelevant since this is not a novel feature but rather design choice of the inventor.

As a result, the claims are written such that they read upon the cited references.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, and 4-26 are rejected under 35 USC 103(a) as being unpatentable over **Stille et al. (US PGPUB 2002/0128028 A1, hereinafter Stille)** in view of **Anderson et al. (US Patent 6,148,198, hereinafter Anderson)**.

Consider **claim 1 (and similarly applied to claims 5, 15, 16, 19-22, and 27-29)**. Stille discloses a method, comprising:

maintaining partner information about predefined partner networks, the partner information indicating that network operators share a serving network node (figure 2, paragraphs 6-8, 21, read as route outgoing packets through the correct home network. In order for this to occur the information about the partner must be maintained. In addition, using information the shared radio network is utilized for determining which one of the shared radio network owners the visiting MT is going to be connected to (paragraph 12)), and

selecting, in the network apparatus, a gateway network node for a mobile station served by the serving network node on the basis of the partner information (paragraph 11, read as routing outgoing packets through the correct home network. In addition, the SGSN 9 then uses the DNS 22 to find out which GGSN:s 16, 17, 18, 19 that may be used, and switches the MT:s 2, 3 to the correct GGSN:s, 16, 17, 18, 19, establishing PDP contexts (paragraph 30)),

wherein the selecting of the gateway network node for the mobile station on the basis of the partner information comprises specifying a mobile station is not visiting; and informing the gateway network node that the mobile station may use the network (paragraphs 27, 28, and 30,

read as that the IMSI provides information that specifies that the MT2 is not visiting (i.e. in a predefined partner network), and the SGSN then has accessed information about which operator the MT2 is subscribed to and which home network the MT2 shall use. Stille further discloses that if, however, an MT4 that is subscribed to an operator that is not one of the owners of the shared network (i.e. in a network outside them), the SGSN contacts a HLR of that MT's home network and uses the IMSI to find out that the MT4 is a visiting MT. It is further noted that in a conventional cellular network, one of the first procedures taken is determining the identity of the mobile station in order to properly provide service. Therefore, if it is determined that the mobile station is in its home network, the conventional cellular network proceeds as normal. Moreover, Stille teaches that two of the MTs: 2, 3 are subscribed to operator A and operator B, respectively. The HLRs 10, 11 are contacted and inform the SGSN 9 that the subscribers may use the APNs 12, 13 that are chosen).

Stille substantially discloses the claimed invention but fails to explicitly teach checking on the basis of the partner information whether a mobile station is in a predefined partner network of a home network; and selecting the gateway network node of the home network if the mobile station is in a predefined partner network of the home network.

However, Anderson teaches checking on the basis of the partner information whether a mobile station is in a predefined partner network of a home network; and selecting the gateway network node of the home network if the mobile station is in a predefined partner network of the home network (column 3 lines 40-43, 53-65, read as classifying service providers such as home service provider, partner service provider etc. and then selects the best service provider).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Anderson into the invention of Stille in order to provide an intelligent roaming method and system for enabling a mobile station to select a best provider from a plurality of service providers (column 2 lines 11-13).

Consider **claim 2 and as applied to claim 1**. Stille discloses wherein the partner information comprises direct or indirect indications of the network in which the mobile station is located, and of the home network of the mobile station (paragraph 28).

Consider **claim 4 and as applied to claim 1**. Stille discloses wherein the selecting a gateway network node for the mobile station on the basis of the partner information comprises checking on the basis of the partner information whether the mobile station is in a network that is a predefined partner network of the one belonging to its home network operator; and selecting the gateway network node of a visited network if the mobile station is in a network that is a predefined partner network of the one belonging to its home network operator (paragraphs 28, 30).

Consider **claim 6 and as applied to claim 5**. Stille discloses wherein the partner information is maintained in the serving network node to indicate the networks sharing the serving network node (paragraphs 21, 22).

Consider **claim 7 and as applied to claim 6**. Stille discloses wherein the serving network node is configured to compare the mobile network code/mobile country code of the mobile station, in connection with the context activation of the mobile station, with access point name operator identifiers stored for each network operator sharing the serving network node,

said mobile network code/mobile country code indicating explicitly the home network of the mobile station and said access point name operator identifier indicating implicitly the partner information (paragraph 21).

Consider **claim 8 and as applied to claim 5**. Stille discloses wherein the serving network node is also configured to connect a mobile station located in a mobile network that is a predefined partner network of its home network to the gateway network node of the home network (paragraphs 27, 28).

Consider **claim 9 and as applied to claim 5**. Stille discloses wherein the partner information is maintained in a subscriber register (paragraph 21).

Consider **claim 10 and as applied to claim 9**. Stille discloses wherein the subscriber register is configured to check the partner information in connection with the location update of the mobile station; set the value of a "Visitor-PLMN address allowed"-flag to 'No' if the mobile station is in a predefined partner network of the home network; and indicate the value of the flag to the serving network node (paragraphs 21-27).

Consider **claim 11 and as applied to claim 5**. Stille discloses wherein the serving network node is also configured to connect the mobile station located in a predefined partner network of its home network to the gateway network node of the home network (paragraph 28).

Consider **claim 12 and as applied to claim 5**. Stille discloses wherein the subscriber register is configured to check the partner information in connection with the location update of the mobile station, the partner information comprising at least one network belonging to the home network operator; set value of the "Visitor-PLMN address allowed"-flag to 'Yes' if the

mobile station is located in a network that is a predefined partner network of the one belonging to its home network operator; and indicate the value of the flag to the serving network node (paragraphs 21-27).

Consider **claim 13 and as applied to claim 5**. Stille discloses wherein the serving network node is also configured to connect the mobile station located in a predefined partner network of the one belonging to its home network operator to the gateway network node of the visited network on the basis of the partner information, the partner information comprising at least one network belonging to the home network operator (paragraph 28).

Consider **claim 14 and as applied to claim 9**. Stille discloses wherein the subscriber register is configured to compare the mobile network code/mobile country code of the mobile station with access point name operator identifiers stored for each network operator sharing the network in connection with the location update of the mobile station; and indicate the result of the comparison to the serving network node (paragraph 21).

Consider **claim 17 and as applied to claim 16**. Stille discloses a third routine configured to maintain partner information (paragraphs 28, 30).

Consider **claim 18 and as applied to claim 16**. Stille discloses wherein the apparatus is a serving general packet radio service support node of a general packet radio service network (paragraphs 21, 27).

Consider **claims 23-26 and as applied to claims 1, 5, 15, and 16, respectively**. Stille and Anderson discloses wherein the selecting of the gateway network node for the mobile station

on the basis of the partner information comprises checking on the basis of the partner information whether the mobile station is in the home network, in a predefined partner network of the home network, or in a network outside them; selecting the gateway network node of the home network if the mobile station is in its home network; and selecting the gateway network node of a visited network if the mobile station is outside its home network or predefined partner mobile networks of its home network (Anderson; column 3 lines 53-65).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street

Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Brandt whose telephone number is (571) 270-1098.

The examiner can normally be reached on 7:30a.m. to 5p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2617

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

/Christopher M Brandt/
Examiner, Art Unit 2617
May 11, 2009

/George Eng/
Supervisory Patent Examiner, Art Unit 2617